



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,979	01/18/2002	Melanie Maas-Brunner	49769	8231
26474	7590	10/05/2004	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			PRICE, ELVIS O	
		ART UNIT	PAPER NUMBER	
		1621		

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/913,979	MAAS-BRUNNER ET AL.
	Examiner	Art Unit
	Elvis O. Price	1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 March 2004 and 15 July 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11-30 is/are pending in the application.
 4a) Of the above claim(s) 11,13,17,19,23,25,27 and 29 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 12,14-16,18,20-22,24,26,28 and 30 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. Claims 11-30 are pending in the application.
2. Claims 11, 13, 17, 19, 23, 25, 27 and 29 still remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
3. Applicants are correct in stating that the US 2488082 Patent corresponds to Galitzenstein et al. The name "Gottfried" is apparently the middle name of the inventor "Galitzenstein" [et al.].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 14-16, 18, 20-22, 24, 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galitzenstein et al. {U.S. Pat. 2,488,082}, in view of Vedage {US Pat. 5,444,170}.

Applicants claim, in brief, a process for preparing at least one hydrogenated alcohol comprising, (1) reacting an alkali or alkali earth metal hydroxide with at least one alcohol to form a mixture, (2) reacting at least one ketone compound with at least one alkyne and the said mixture to form an unsaturated alcohol, (3) hydrogenating the unsaturated alcohol to form the hydrogenated alcohol mixture and (4) distilling the

hydrogenated alcohol mixture to separate the hydrogenated alcohol before recycling the unsaturated alcohol and solvent.

Galitzenstein et al. teach a process for preparing an unsaturated alcohol comprising reacting an alkali hydroxide with an alcohol to form a mixture then reacting a ketone (acetone) with an alkyne (acetylene) and the said mixture to form the unsaturated alcohol (alkynol) (see Examples 1 and 2). The difference between applicants' claimed invention and the reference is that the reference does not teach hydrogenating the unsaturated alcohol to prepare the hydrogenated alcohol.

Vedage teaches a process for hydrogenating acetylenic compounds (e.g., alkynols prepared by condensing ketones with acetylene) so as to prepare hydrogenated alcohols (see Comp. Example I, Example 2, and Example 5).

It would have been clearly *prima facie* obvious to one of ordinary skill in the art, in view of the cited references, to arrive at the presently claimed invention, because Galitzenstein et al. teach a similar process for preparing an unsaturated compound (condensing a ketone with acetylene with a previously prepared alkali alcoholate) and Vedage teaches a process for hydrogenating acetylenic compounds so as to prepare the hydrogenated alcohol.

One having ordinary skill in the art, desiring to arrive at alternative methods of preparing hydrogenated alcohols, depending on cost, convenience and availability of materials, would have been motivated to couple the hydrogenation method taught by Vedage with the alkynol production method taught by Galitzenstein et al.

Response to Arguments

Applicant's arguments filed 3/25/04 have been fully considered but they are not persuasive.

Applicant argues that the now amended claim 12, now drawn to a continuous process for the synthesis of alcohols is unobvious over the Galitzenstein et al. and/or the Vedage reference because neither reference or their combination teach or suggest carrying out the process continuously.

This argument is not found convincing because Galitzenstein et al. teach that their invention can be carried out cyclically (e.g. continuously) (see Col. 2, lines 43-55 through Col. 3, lines 1-37). Additionally, the Examiner would like to remind applicants that a continuous process is *prima facie* obvious over a non-continuous process, absent any unexpected results, considering that most processes are converted to continuous processes upon industrialization so as to afford a more industrial adequate process in terms of convenience, economics and overall efficiency.

Applicants also argue that it is advantageous to carry out the presently claimed process continuously because the space-time yield obtained from the presently claimed invention is about 20 times as high as the space-time yield of example 1 of the Galitzenstein et al. invention.

This argument is not convincing because the Examiner finds the above assertion unfounded. The results of the Galitzenstein et al. Example 1 appear to be better than that of Example 4 of the present application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

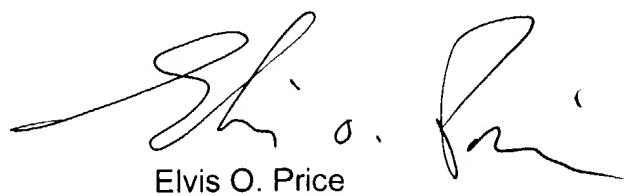
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 571 272-0644. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571 272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

Application/Control Number: 09/913,979
Art Unit: 1621

Page 6



Elvis O. Price

October 1, 2004